

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 13-17 are rejected under 35 USC 103(a) over the U.S. patent to Krasznai in view of the U.S. patent application publication to Lenkiewicz.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claim 13, the broadest claim on file, and added dependent Claim 21.

Before the analysis of the prior art it is believed to be advisable to explain the new features of the present invention as defined in Claim 13, the broadest claim on file.

Claim 13 defines a dust-collection container for a hand-held power tool (10) with a dust-extraction device, comprising the following elements:

a container wall enclosing a dust-collecting volume and provided with a dust-intake opening (19) for connection to a dust-discharge adaptor (18) of the hand-held power tool (10);

a substantially rectangular viewing window (21) located in said container and having four straight edges including at least two straight edges extending substantially perpendicular to one another;

two straight filling marks (29, 30) provided in said viewing window (21) and each extending parallel to a respective one of said two substantially perpendicular straight edges so as to form a cross;

a combination of letters substantially corresponding to a word "maximum" for indicating a maximum filling of dust and each provided near each of said straight filling marks (29, 30),

said straight filling marks (29, 30) extending over a full length and a full width of said viewing window (21) at a right angle to each other to identify a recommending maximum filling level when the dust-collecting container is oriented substantially horizontally and substantially vertically respectively;

a cover (23) connected with said container wall and covering said dust-collecting volume;

and a filter element associated with said cover (23).

Turning now to the prior art applied by the Examiner in his rejection of the claims, it is respectfully submitted that the new features of the present invention as defined in Claim 13 are not disclosed in the references.

The patent to Krasznai discloses only the substantially rectangular viewing window (36) with four straight edges including at least two substantially perpendicular edges, but does not disclose any filling marks and any combinations of letters.

The patent to Lenkiewicz does not disclose a viewing window which is rectangular as in the applicant's invention.

The filling marks in the viewing window of the patent to Lenkiewicz do not extend over a full length and a full width of the viewing window as in the applicant's invention.

Actually, in the Lenkiewicz reference there is no viewing window, but instead the whole wall of the container is made transparent. Therefore, in the Lenkiewicz reference it cannot be said that the container has a window with the four straight edges including two straight edges extending perpendicular to one another.

It is therefore believed to be clear that the Lenkiewicz reference also does not teach the new features of the present invention as defined in amended Claim 13.

As for the combination of the references, it is hardly obvious to combine the rectangular window of the patent to Krasznai which occupies a part of a wall of the container, with the whole fully transparent wall of the container of Lenkiewicz reference to arrive at some compromisable viewing window. The combination of the references also do not lead to a dust-collection container in which the filling marks extend over a full length and a full width of the viewing window and parallel to the straight edges of the viewing window.

The above-mentioned differences of the viewing window of the container in accordance with the present invention from the references provide for the highly advantageous results in that the recognition of the fill level of the container in its horizontal position and in its vertical position can be really recognized by the viewer.

It is therefore believed to be clear that the new features of the present invention as defined in Claim 13 are not disclosed in the references and cannot be derived from the references either taken singly, or in combination with one another.

The Examiner rejected the claims over the combination of the references. It is respectfully submitted that the present invention cannot be derived from the references taken singly or from the

combination. In order to arrive at the applicant's invention as defined in Claim 13 from the references taken singly and in combination with one another, the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in Claim 13 and which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained hereinabove, the present invention provides the highly advantageous results which cannot be accomplished by the containers disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above, it is respectfully submitted that Claim 13 should be considered as patentably distinguishing over the art and should be allowed.

The Examiner's attention is respectfully directed to the features of Claim 21. This claim specifically defines that the edges of the viewing window are inwardly spaced from the sides of the container wall provided with the viewing window, the straight filling marks are spaced from the corresponding straight edges of the viewing windows, and the compositions of the letters defining the maximum filling level are located between the straight filling marks and the edges of the viewing window.

This feature provides an improved recognition of the combinations of the letters and therefore of the corresponding filling level.

The patent to Krasznai does not disclose this feature at all. In the Lenkiewicz reference the "fill line" composition of letters is located not in a space between the filling mark and the corresponding edge, but

instead under the filling mark, while the “full” composition of letters is located on top of the filling mark and below the upper end of the container wall shown in Figure 3.

It is believed to be clear that the new features of the present invention as defined in Claim 21 are also not disclosed in the references and cannot be derived from them as a matter of obviousness, and therefore Claim 21 should be considered as patentably distinguishing over the art not only because it depends on the allowable Claim 13, but also because it contains the patentable subject matter per se.


As for the other dependent claims, these claims depend on Claim 13, they share its allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be

carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker  
Attorney for Applicants  
Reg. No. 27233